



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: E. David Neufeld et al. § Art Unit: 2185  
Serial No.: 10/039,018 §  
Filed: December 31, 2001 § Examiner: Zhuo H. Li  
For: Method to Increase the Life § Atty. Dkt. No.: 200304388-1  
Span of Limited Cycle § (HPC.0032US)  
Read/Write Media §

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

All claims were rejected as being obvious over Kriegsman and Lofgren. It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to the claimed subject matter for at least the following reason: no motivation or suggestion existed to combine the teachings of Kriegsman and Lofgren. M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 3), at 2100-135.

With respect to claim 1, the Office Action identified Kriegsman as disclosing a static file and a dynamic file. 4/5/2006 Office Action at 3. However, the Office Action conceded that Kriegsman does not teach the two migrating acts of claim 1: migrating the file to a dynamic region of the read/write storage medium if the file is a static file; and migrating the file to a static region of the read/write storage medium if the file is a dynamic file. *Id.* Instead, the Office Action cited Lofgren as disclosing the claim elements that are missing from Kriegsman. *Id.*

Date of Deposit:

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Ginger Yount

As discussed in the previous Reply to Office Action, it is clear that no motivation or suggestion existed to combine the teachings of Kriegsman and Lofgren. In response to the arguments presented in the previous reply, the Office Action made the following points:

(1) non-obviousness cannot be shown by attacking references individually where the rejections are based on combinations of references; and

(2) “the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references[; rather] the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” 4/5/2006 Office Action at 8.

With respect to point (1) above, Applicant’s arguments cannot be properly characterized as attacking references individually -- Applicant merely provided explanations of what each of the references taught, and why a person of ordinary skill in the art would not have been motivated to combine the teachings of these references based on the actual teachings of the references. As stated by *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), a case also relied upon by the Examiner, the PTO has the burden of establishing a *prima facie* case of obviousness, and the PTO can satisfy this burden “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art will lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d at 1074. Thus, it is clear from well-established case law that the actual teachings of the references are highly relevant in determining whether any evidence exists of the required motivation or suggestion to combine references in the context of an obviousness rejection. Therefore, Applicant’s discussion of the references in rebutting the obviousness rejection is entirely proper.

As to point (2) made by the Office Action, the Office Action has mischaracterized Applicant’s arguments. Applicant is not arguing whether features of Lofgren can be bodily incorporated into the structure of Kriegsman, the primary reference. Rather, Applicant is arguing that based on the teachings of Kriegsman and Lofgren, a person of ordinary skill in the art would clearly not have been motivated to modify the teachings of Kriegsman based on the teachings of Lofgren. As stated by the M.P.E.P., one of the factors considered in determining the appropriateness of modifying a primary reference based on teachings of a secondary reference is whether the proposed modification would render the reference being modified unsatisfactory for

its intended purpose. M.P.E.P. §2143, at 2100-137. If so, then there is no suggestion or motivation to make the proposed modification. *Id.*; see also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (holding that a *prima facie* case of obviousness was not established where the proposed modification of the apparatus of the cited reference would render the apparatus inoperable for its intended purpose).

Kriegsman states that static files are files that are repeatedly transferred in a network of computer systems without changes, while dynamic files are files that are modified for each transfer in the network. Kriegsman, 1:7-12. Kriegsman discloses a web serving system 10 (depicted in Fig. 1 of Kriegsman) that includes a primary web server 14 and one or more secondary web servers 16. Kriegsman, 5:14-18. The primary web server 14 includes a primary computer 28, storage hardware 30 connected to computer 28, web server software 32, and a primary communications link 38. Kriegsman, 5:52-58. Each secondary web server 16 includes a secondary computer 44, storage hardware 46 connected to secondary computer 44, web server software 48, and a secondary communications link 54. Kriegsman, 6:27-35. Secondary storage hardware 46 of the secondary web server 16 is used for storing data files that are duplicates of the original data files in primary storage hardware of the primary web server 14. Kriegsman, 6:35-38. Static files that are consuming most of the capacity of the communications link are copied to the one or more secondary web servers 16. Kriegsman, 6:67-7:5. Once the static data files have been copied to the secondary web servers 16, only original dynamic data files need to be transferred through the primary communications link. Kriegsman, 7:63-66. The static data files that are requested by web browsers are transmitted over secondary communications links (rather than the primary communications link). Kriegsman, 7:66-8:3.

Thus, what is taught by Kriegsman is the use of secondary web servers to satisfy requests for static files, and the use of the primary web server to satisfy requests for dynamic files. Clearly, the teachings of Kriegsman provide no suggestion of migrating a static file to a dynamic region of a read/write storage medium, and migrating a dynamic file to a static region of *the* read/write storage medium. Rather, a person of ordinary skill in the art looking to the teachings of Kriegsman would have been taught to provide static files on separate web servers (that are separate from a primary web server) to achieve enhanced communications speeds when responding to requests for static files and dynamic files from web browsers.

A person of ordinary skill in the art would not have been motivated to modify the teachings of Kriegsman based on the teachings of Lofgren. Lofgren refers to moving data between heavily used and least used banks of an EEPROM memory 11 to achieve wear leveling. This goal of Lofgren is clearly inconsistent with the goal of Kriegsman, which is to separate dynamic files and static files on completely different storage media associated with different primary and secondary web servers. If the teachings of Lofgren were to be applied to Kriegsman, then a person of ordinary skill in the art would have been led to storing both the dynamic and static files of Kriegsman in a single storage medium associated with a single web server in Kriegsman, which directly contradicts the stated goal of Kriegsman (to distribute static files to separate secondary web servers so that a communications bottleneck does not occur at the primary web server). Clearly, modifying Kriegsman based on the teachings of Lofgren would defeat the intended purpose of Kriegsman, which is a clear indication that no motivation or suggestion existed to combine the teachings of Kriegsman and Lofgren to achieve the claimed invention. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” M.P.E.P. § 2143.01, at 2100-137.

The following is another basis to support Applicant’s arguments that no motivation or suggestion existed to combine the teachings of Kriegsman and Lofgren. By teaching that dynamic files are kept in a primary web server and static files are kept in a secondary web server, Kriegsman is actually teaching that the dynamic files be maintained in the storage hardware of the primary web server. The continued storage of dynamic files in the storage hardware of the primary web server necessarily means that the storage hardware of the primary web server would be subject to more wear than the storage hardware of the secondary web server, which contains static files that do not change. Yet Kriegsman specifically teaches that the dynamic files should remain in the primary web server to achieve enhanced communication speeds. This teaching of Kriegsman is directly inconsistent with the teachings of Lofgren and what is recited in the claim. The migrating of a static file to a dynamic region and a dynamic file to a static region, as performed in claim 1, is for enhancing a lifespan of a read/write storage medium. In contrast, Kriegsman teaches the opposite, requiring that its dynamic files remain in the same location, the primary web server. Therefore, it is clear that the objective evidence of record establishes that a person of ordinary skill in the art would not have been led to combine the teachings of

Kriegsman and Lofgren to achieve the claimed subject matter. Since no motivation or suggestion existed to combine Kriegsman and Lofgren, a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 13 and 17 are allowable for similar reasons. Dependent claims are allowable for at least the same reasons as corresponding independent claims.

In view of the foregoing, it is respectfully requested that the final rejections of the claims be withdrawn. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (200304388-1).

Respectfully submitted,

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Dan C. Hu  
Registration No. 40,025  
TROP, PRUNER & HU, P.C.  
1616 South Voss Road, Suite 750  
Houston, TX 77057-2631  
Telephone: (713) 468-8880  
Facsimile: (713) 468-8883